

Appl. No.:09/991,428  
Amdt. dated October 10, 2006  
Reply to Office Action of July 11, 2006

### REMARKS/ARGUMENTS

In the Office Action dated July 11, 2006, claims 1-76 remain pending, and were rejected.  
In the Office Action:

- 1) Regarding the IDS previously submitted, three references were not considered since copies were not provided for the corresponding references, which were non-patent or foreign patents. Applicant apologizes for the error by the prior prosecuting attorney, and has submitted the references.

Applicant also informs the Examiner that the Applicant has submitted updated Power of Attorney information, reflecting that the firm of Alston & Bird (not Fenwick & West) is now prosecuting the present application.

- 2) Claims 28, 30, 36, and 67 were objected to because of various informalities. Applicant notes the suggestions provided by the Examiner and has amended the claims appropriately. Applicant submits the objections may be now withdrawn.
- 3) Claims 29 and 58 were rejected to under 35 U.S.C. § 112 as being indefinite due to lack of proper antecedent basis for certain limitations. Applicant has amended the claims to overcome the rejection, and requests the rejections be withdrawn.
- 4) Claims 68, 71, and 73-74 were rejected under 35 U.S.C. § 102(b) in light of U.S. Patent 5,878,400 ("Carter"). Applicant has cancelled claims 68 and 70, and has rewritten claim 69 into independent form with claims 73-74 depending from claim 69, thereby rendering the rejection moot. Applicant request that the rejections be withdrawn.
- 5) The remaining claims were variously rejected under 35 U.S.C. § 103(a) as being unpatentable in light of U.S. Patent 5,878,400 ("Carter") in view of various prior art references, namely:
  - a. Claims 1-4, 7-10, 12-15, 17-19, 21, 24, 26-32, 34-36, 38, 41, 43-49, 52, 54, 56-58, 60, 63, 65-67, 69-70, and 75-76 were rejected 35 U.S.C. § 103(a) as being unpatentable over Carter in view of U.S. Patent 6,460,020 ("Pool").

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- b. Claims 5-6, 33, and 50-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter, in view of Pool, and further in view of U.S. Patent 6,049,671 ("Slivka").
- c. Claims 11 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter, in view of Pool, and further in view of "Thurston, Charles W., "Mercosur's Size Requires Multiplicity in Ventures," Journal of Commerce, 5<sup>th</sup> ed., New York, March 17, 1999 ("Mecosur").
- d. Claims 16 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter, in view of Pool, and further in view of Hudgins, Christy, "International E-Commerce," Network Computing, November 15, 1999, pp. 75-92. ("Hudgins").
- e. Claim 20, 22-23, 37, 39-40, 59, and 61-62 are rejected 35 U.S.C. § 103(a) as being unpatentable over Carter, in view of Pool, and further in view of U.S. Patent Application No. 2004/0024739 ("Copperman").
- f. Claim 72 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter, in view of Hudgins.

Applicant is addressing the rejections of all these claims (except for claim 68, which has been cancelled).

#### DISCUSSION

In addressing the rejected claims as identified in part 5a-f above, each of the rejections relied upon the Carter reference for disclosing various limitations. Specifically, for independent claim 1 (and associated dependent claims 2-28), independent claim 29 (and associated dependent claims 30-45), and independent claim 46 (and associated 47-67), Carter was cited as disclosing the following limitations:

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a harmonized system (HS) module for storing information describing a country's HS tree, the HS tree having a hierarchy of nodes in which goods can be classified; and

a tariffs module for storing information describing tariffs applicable to goods classified in nodes of the HS tree

In regard to newly formed independent claim 69 (and associated dependent claims 71-76), a similar limitation is found with respect to stored data describing the above.

Applicant submits that a *prima facie* case of obviousness has not been met and that the combination of references is improper, not does it render obvious the above limitations.

#### Carter is Nonanalogous Art

First, the Carter reference is nonanalogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (*In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992) (MPEP 2141.01(a)). The Carter reference is neither in the field of applicant's endeavor, nor is it reasonably pertinent to the particular problem with which the inventor was concerned.

First, the field of the applicant's endeavor is providing landed costs. (See specification, page 8). The difficulty in providing landed costs, which include the total cost of shipping goods from a specified origin to a specified destination is that the freight insurance, customs tariffs, taxes, currency exchange rates, fuel surcharges are out of the control of the user. Typically the seller and the buyer have a clear understanding of the price that the seller charges for the goods. However, the other costs listed above are beyond the control of the buyer and seller. Thus, providing the landed cost is difficult. "Landed costs" is not the selling price of the goods.

Carter discloses a price quotation system for the price of the goods that the seller will charge the buyer. Thus, Carter focuses on providing a "selling price" of the goods. Carter focuses on who is buying the goods, in order to ascertain any discounts (presumably from the retail price). (Carter, Abstract, col. 3). Discounts on price are ascertained based on who is

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buying what products. These variables are entirely within the control of the seller. In contrast, components of the landed cost, such as fuel surcharge, duties, exchange rates, etc. are not within the control of the buyer and seller, and do not depend on who is purchasing the good. For example, a seller cannot "fix" international exchange rates, nor ascertain what a third party will charge for a fuel surcharge.

Further, Carter is not reasonably pertinent to the particular problem which the inventor was concerned with. One aspect of the present invention pertains to determining the proper classification of goods for international trade purposes. Those skilled in the art of international trade will recognize that identifying the proper classification of a good via the harmonized tariff codes (HTC) is notoriously difficult. In fact, commercial practice of such a skill requires certification by the U.S. Government by way of the U.S. Customs Licensing Examination in order to become a certified import/export broker. In contrast, Carter deals with providing determining the appropriate discount to a purchaser of goods sold. It is a pricing system designed to accommodate discounts for purchasers of goods. It does not address international trade specific issues. In short, "purchasing" a good is not the same as "importing" a good.

Applicant submits that Carter is not analogous art for purposes of combining with other references.

### ***A Prima Facie Case of Obviousness Has Not Been Established***

Establishment of a *prima Facie* case of obviousness requires three criteria to be met. First, there must be some suggestion or motivation to combine or modify the references. Second, there must be reasonable expectation of success. Third, the prior references when combined must suggest or teach all the claimed limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2142).

#### **1. No Motivation to Combine**

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The motivation to combine can come from the nature of the problem to be solved, the teachings  
of the prior art, and the knowledge of person of ordinary skill in the art. *In re Buffington*, 140 F.2d